

REMARKS

Claims 19-41 are pending in the application. Claims 1-18 were previously cancelled. None of the claims were objected to. However, all of the pending claims were rejected. Applicant has not amended any of the claims, but the claims are listed above for reference. Applicant submits that the pending claims are patentable for the reasons discussed in detail below.

Summary of Telephone Interview:

A telephone interview was held on April 28, 2004 with Examiner S. Gravini to clarify understanding of the Final Office Action. In general, Examiner Gravini explained that the initial application as filed was examined by the business methods art unit, which was determined based on the claims originally filed by another firm. Although all of the originally filed claims were cancelled, and new claims directed to computer related inventions, the application remains in the business method art unit. Accordingly, special procedures used to examine business methods would still be used to examine the subject application.

One of those special procedures includes a comprehensive review by a "101 panel" to ensure that the claims are useful, concrete, and tangible result such that the invention would be considered within "technological arts" or "useful arts." Applicant's attorney pointed out that the current claims are tied to a mobile device, and asked for clarification on why the claims were rejected under 35 USC § 101. The Examiner reviewed the claims and indicated that a clear indication of the relationship to the mobile device may be satisfactory for the 101 panel. However, no agreement was reached during the telephone interview.

With regard to a requirement for information, Examiner Gravini clarified that additional information related to business practices and business ventures at the time of the invention would help the 101 panel review the application. Applicant's attorney explained that the invention was not publicly used prior to filing the patent application, so there were no public business practices or business ventures. The Examiner pointed out that a response that no information was available is considered fully responsive.

use of the claimed invention at the time the application was filed, are unknown and/or are not readily available. Instead, applicants submitted information disclosure statements (IDSs) approximately January 29, 2001 and approximately January 16, 2002. The IDSs indicate the extent of information known or used at the time the application was filed and to date. Accordingly, applicants respectfully request that the above be accepted as a complete reply and the requirement for additional information be withdrawn.

Incorporation by Reference Into the Specification:

The Final Office Action repeats the information requirement given in the first non-final office action. Specifically, the Final Office Action reiterates that applicant is required to amend the specification to explicitly include relevant portions of three applications that were incorporated by reference. Although the three applications are not identified, the Final Office Action indicates that such an amendment must be accompanied by a declaration stating that the amendatory material consists of the same material incorporated by reference. Alternatively, the Final Office Action requires amending the specification to remove the statements that incorporate the patent applications by reference. In addition, the Final Office Action also appears to suggest that a copy of relevant portions of the incorporated applications would be helpful for examination of the claimed invention.

Applicant's attorney explained in a previous amendment, filed November 13, 2003, that no applications were incorporated by reference in the specification. However, that explanation was an error based on an incomplete copy of the filed patent application that was transferred from a prior law firm that originally filed the patent application. Having investigated the true content of the patent application as filed, the following remarks address the incorporation by reference.

Applicant contends that the incorporations by reference are proper. MPEP § 608.01(p)(I)(a) states that "essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign

application.” The three incorporated references are all U.S. applications, and not foreign patents nor foreign publications. There is no indication that the three incorporated applications themselves incorporate other essential material by reference. Thus, the three incorporated applications satisfy the restrictions set forth by U.S. Patent and Trademark Office.

In any case, applicant intends that the incorporated patent applications be published via patent issuance. Thus, the content of the incorporated applications will be available to the public. Accordingly, the incorporation of the three patent applications is proper, and it is again respectfully submitted that the objection to the specification should be withdrawn.

Claims Rejected Under 35 USC § 101:

The Final Office Action has rejected Claims 19-27, 35, and 40 under 35 USC § 101 as failing to recite a useful, concrete, and tangible result such that the invention would be considered within “technological arts” or “useful arts.” Specifically, the Final Office Action states that “the steps of displaying, determining, enabling, communicating or providing, employing or receiving, measuring, and sending are considered nothing more than an abstract idea since it is not tied to any technological art.” (Final Office Action, pg. 9). However, these words of the claims can not be taken in isolation. Applicant respectfully contends that the claims recite these words in relation to tangible and useful elements such as “a computer-implemented method,” “a carrier wave signal for a mobile network,” and “a system for a mobile network, comprising: an application server; a base station subsystem; a location management unit; and a mobile terminal.” In fact, each of the rejected claims includes the above words in relation to a tangible and useful “mobile terminal.” The MPEP warns that “[o]nly when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.” (MPEP § 2106.II.A.). Each rejected claim includes a limitation to a practical application of providing location-specific content through a mobile terminal. Thus, each step and/or element is tied to a technological art, and produces a concrete and reproducible result.

Moreover, the claims express a useful, concrete, and tangible result. The claims enable and/or cause content to be displayed with a mobile terminal. The content is related to the location

of the mobile terminal and related to a linked resource. Clearly, this result is more useful than displaying content that bears no relation to the location of the mobile terminal. Even if the content is not actually displayed, but is simply available for display by the mobile terminal, the result is useful, since the content is available to a user of the mobile terminal. Such a result is also concrete and tangible, since, by definition, the content must be embodied in a form that the mobile terminal can display. Even the State Street Bank case indicates that actual display is not needed. Instead, State Street allows states transformed data need only be “momentarily fixed for recording and reporting purposes” (MPEP § 2106.II.A., citing *Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). The State Street Bank case provides an abstract example that “‘transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result.’” (Id.) Clearly, determining a mobile terminal location and enabling the mobile terminal to display content related to the location of the mobile terminal is at least as useful, concrete and tangible. Accordingly, the rejection of 19-27, 35, and 40 under 35 USC § 101 should be withdrawn.

In addition, applicant notes that, although previously cancelled claims 1-6, and 11-13 were rejected under 35 USC § 101, current Claims 19-27, 35, and 40 are rejected for the first time in the current Final Office Action. Claims 19-27, 35, and 40 were newly added in the only previous amendment, which was filed November 13, 2003, to overcome differing grounds of rejection. This is evidenced by the Final Office Action, which states that “[a]pplicant’s arguments with respect to Claims 19-40 have been considered but are moot in view of the **new grounds of rejection.**” (emphasis added, Final Office Action, pg. 11 (although printed as “Page 2”)). Thus, a clear issue has not yet been developed between the examiner and applicant. (See MPEP § 706.07). Accordingly, applicant respectfully requests that at least the finality of the rejection under 35 USC § 101 be withdrawn.

Claims Rejected Under 35 USC § 102:

Claims 19-27 Rejected Under 35 USC § 102(b) Over Rosin:

Claims 19-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rosin et al. (WO 99/09744, hereinafter referred to as Rosin). However, the Final Office Action does not specify any portion of the cited reference that discloses or suggests elements of the claimed invention. 37 CFR 1.104(a)(2) requires that “[t]he reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.” Applicant submitted the Rosin reference in an IDS with the good faith belief that Rosin did not anticipate applicant’s invention. The Final Office Action does nothing but identify a reference with which the applicant is already aware. Thus, applicant respectfully contends that the Final Office Action does not meet the requirement of providing reasons be stated and information given that may be useful in aiding applicant to judge the propriety of continuing the prosecution.

Further, the principles of the administrative procedure act (APA) and longstanding precedent requires an agency such as the US Patent and Trademark Office to articulate sustainable reasons for their decisions in the written record. (See APA § 706 and *SEC v. Chenery Corp.*, 318 U.S. 80 (1943)). “Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.” *Allentown Mack Sales and Service, Inc. v. NLRB*, 118 S. Ct. 818 (1998). The Final Office Action does not articulate any reasoning for its conclusion that Rosin anticipates applicant’s invention. Without any reasoning, this conclusion can only be considered arbitrary and capricious. Accordingly, the rejection of Claims 19-27 under 35 U.S.C. § 102(b) should be withdrawn. At the very least, the finality of the rejection should be withdrawn and reasons articulated.

Notwithstanding the discussion above, applicant contends that Rosin does not disclose every element of applicants claims. For example, applicant finds no indication that Rosin discloses or suggests the claimed element of automatically employing the location of the mobile terminal to determine content that is related the location of the mobile terminal. At best, Rosin rosin discloses a

remote control device 26 “to allow the user convenient control of both the interactive ticker and television functions through specification explains that-top box 12.” (Rosin, pg. 5, lines 24-26). Applicant finds no evidence that a location of remote control device 26 is determined, let alone employing a location of remote control device 26 to determine content that is related to a location of remote control device 26.

Because Rosin does not disclose every element of independent Claim 19, the rejection of independent Claim 19 under 35 U.S.C. § 102(b) should be withdrawn. Further, a dependent claim is considered to include all of the elements of the independent claim and any intervening claims from which the dependent claim depends. Thus, Rosin does not disclose every element of dependent Claims 20-27. Accordingly, the rejection of dependent Claims 20-27 under 35 U.S.C. § 102(b) should also be withdrawn.

Claims 28-33 Rejected Under 35 USC § 102(b) Over Aeschlimann:

Claims 28-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Aeschlimann et al. (WO 00/29979, hereinafter referred to as Aeschlimann). However, again the Final Office Action does not specify any portion of the cited reference that discloses or suggests elements of the claimed invention. For the regulatory and statutory reasons discussed above, the rejection of Claims 28-33 under 35 U.S.C. § 102(b) should be withdrawn.

In addition, Aeschlimann is an international application published under the PCT in what appears to be the German language. Only the abstract appears to be translated into English. MPEP § 706.02 states that “[c]itation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate . . .” At the very least, a rejection based only on the abstract should be made only “in a non-final Office action.” (See, Id.). Accordingly, at least the finality of the rejection of Claims 28-33 under 35 U.S.C. § 102(b) should be withdrawn.

Further, the English abstract of Aeschlimann does not disclose or suggest every element of the rejected claims. For example, applicant does not find any indication of displaying, selecting,

or communicating a link to a resource. Because Aeschlimann does not disclose every element of independent Claim 28, the rejection of independent Claim 28 under 35 U.S.C. § 102(b) should be withdrawn. Also, because a dependent claim is considered to include all of the elements of the independent claim and any intervening claims, Aeschlimann does not disclose every element of dependent Claims 29-33. Accordingly, the rejection of dependent Claims 29-33 under 35 U.S.C. § 102(b) should also be withdrawn.

Claim 34 Rejected Under 35 USC § 102(b) Over Blount:

Independent Claim 34 was rejected under 35 U.S.C. § 102(b) as being anticipated by Blount et al. (GB 2 330 503, hereinafter referred to as Blount). However, again the Final Office Action does not specify any portion of the cited reference that discloses or suggests elements of the claimed invention. For the regulatory and statutory reasons discussed above, the rejection of Claim 34 under 35 U.S.C. § 102(b) should be withdrawn.

Further, Blount does not disclose or suggest all of the elements of Claim 34. For example, applicant finds no indication that Blount discloses or suggests the claimed elements of receiving an automatically determined location of the mobile terminal if a link is selected and searching a database to determine content that is related to the link and the automatically determined location. Because Blount does not disclose every element of independent Claim 34, the rejection of independent Claim 34 under 35 U.S.C. § 102(b) should be withdrawn.

Claim 35 Rejected Under 35 USC § 102(b) Over Moncrieff or Gerace:

Independent Claim 35 was rejected under 35 U.S.C. § 102(b) as being anticipated by Moncrieff (U.S. Patent 5,828,839, hereinafter referred to as Moncrieff) or Gerace (U.S. Patent 5,848,396, hereinafter referred to as Gerace). However, yet again the Final Office Action does not specify any portion of either of the cited references that disclose or suggest elements of the claimed invention. Accordingly, for the regulatory and statutory reasons discussed above, the rejection of Claim 35 under 35 U.S.C. § 102(b) should be withdrawn.

Further, Moncrieff does not disclose or suggest all of the elements of Claim 35. For example, applicant finds no indication that Moncrieff discloses or suggests the claimed element of a location of a mobile terminal that is automatically determined. Moncrieff explicitly shows and describes user input screens through which the user must specify the location of the user's computer (which is not described as a mobile computer). Because Moncrieff does not disclose every element of independent Claim 35, the rejection of independent Claim 35 under 35 U.S.C. § 102(b) should be withdrawn.

As for Gerace, applicant notes that the Final Office Action indicates the incorrect U.S. patent number of 5,838,396, which is issued to Shiota et al. and is not in the appropriate art area. The correct number for Gerace was provided in an IDS and is listed above. Gerace also does not disclose or suggest all of the elements of Claim 35. For example, applicant finds no indication that Gerace discloses or suggests the claimed elements of a mobile terminal or a location of a mobile terminal that is automatically determined. In fact, Gerace teaches away from these elements by disclosing that a main routine 39 prompts the user for his zip code or the name of his city. (See, Gerace, col. 16). Because Gerace does not disclose every element of independent Claim 35, the rejection of independent Claim 35 under 35 U.S.C. § 102(b) should be withdrawn.

Claims 36-40 Rejected Under 35 USC § 102(e) Over Wicks:

Claims 36-40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wicks et al. (US 5,949,326, hereinafter referred to as Wicks). However, again the Final Office Action does not specify any portion of the cited reference that discloses or suggests elements of the claimed invention. For the regulatory and statutory reasons discussed above, the rejection of Claims 36-40 under 35 U.S.C. § 102(e) should be withdrawn.

Further, Wicks does not disclose or suggest all of the elements of independent Claim 36. For example, applicant finds no indication that Wicks discloses or suggests the claimed elements of displaying a link to a resource and communicating a selected link to a resource and a location of the mobile terminal to an application server. Wicks simply sends a signal that a predefined button or

icon was activated. A link is well known to include information identifying the resource. However, Wicks simply send a signal that a certain pager activated the predefined button or icon. Because Wicks does not disclose every element of independent Claim 36, the rejection of independent Claim 36 under 35 U.S.C. § 102(e) should be withdrawn. Also, because a dependent claim is considered to include all of the elements of the independent claim and any intervening claims, Wicks does not disclose every element of dependent Claims 37-40. Accordingly, the rejection of dependent Claims 37-40 under 35 U.S.C. § 102(e) should also be withdrawn.

Claim 41 Rejected Under 35 USC § 102(e) Over Degnbol:

Independent Claim 41 was rejected under 35 U.S.C. § 102(e) as being anticipated by Degnbol (WO 00/22860, hereinafter referred to as Degnbol). However, yet again the Final Office Action does not specify any portion of either of the cited references that disclose or suggest elements of the claimed invention. Accordingly, for the regulatory and statutory reasons discussed above, the rejection of Claim 35 under 35 U.S.C. § 102(e) should be withdrawn.

Further, Degnbol does not disclose or suggest all of the elements of Claim 41. For example, applicant finds no indication that Degnbol discloses or suggests the claimed elements of a means for providing a link to a resource to a mobile terminal and a means for, if the link is selected, automatically employing a location of the mobile terminal to determine content that is related to the linked resource and also related to the location of the mobile terminal. Degnbol is directed to automatically alerting a user A of the proximity of a user B. This teaches away from selecting a link to automatically employ the location to determine content. Such a link would be contrary to the principle of Degnbol to automatically alert user A when user B came near. If a link was required, the user A would be required to poll for user B, which is the antithesis of the principle of Degnbol. Because Degnbol does not disclose every element of independent Claim 41, the rejection of independent Claim 35 under 35 U.S.C. § 102(e) should be withdrawn.

Double Patenting Rejection:

Claims 19-40 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-47 of copending Application No. 09/580,442, over Claims 1-16 of copending Application No. 09/580,443, or over Claims 1-13 of copending Application No. 09/981,688. Applicant notes that no rationale is given to support the conclusion that Claims 19-40 are unpatentable over the copending applications. Thus, for the regulatory and statutory reasons discussed above, the provisional rejection should be withdrawn. In addition, applicant notes that each copending application includes a common inventor with the present application. Also, the present application and all of the copending applications were commonly owned and/or subject to an obligation to assign rights to the same assignee at the time of filing the present patent application. Further, applicant notes that the copending patent applications, and the present patent application were all filed after November 29, 1999. Nevertheless, applicant has attached a terminal disclaimer signed by applicant's attorney of record. (See MPEP § 804). Accordingly, the provisional rejection should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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